(34,178)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1928.

No. 869

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE OF CLINTON G. COLGATE, DECEASED, APPELLANT,

vs.

THE UNITED STATES

APPEAL FROM THE COURT OF CLAIMS

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[fols. a & 1]

IN THE COURT OF CLAIMS

No. H-188

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased,

v.

THE UNITED STATES

I. PETITION—Filed May 4, 1927

Arthur E. Colgate, Administrator of the estate of Clinton G. Colgate, respectfully represents:

I. Plaintiff is the duly appointed administrator of the estate of Clinton G. Colgate, who died in the City of New York, on the 23d day of November, 1886. Clinton G. Colgate was a citizen of the United States and resident in his lifetime in the City and State of New York. Plaintiff is likewise a citizen of the United States having domicile and place of business in City of New York, State of New York.

II. Plaintiff's decedent, Clinton G. Colgate, was the assignee and owner of certain letters patent numbered 65019 issued by the United States Patent Office to George B. Simpson, May 21, 1867, covering the use of gutta percha insulation for electrical purposes. The invention covered by said letters patent was the private property of decedent by duly executed and recorded assignments, with all claims and demands for infringements of the said patent or use of the same.

[fol. 2] III. On sundry and divers dates since the said 21st of May, 1867, without any license or permission from the decedent or his assignors, the Government of the United States by its officers and agents, civil and military, took for public use, and after the several dates of taking did continuously use and employ for its own purposes and profit the invention covered by the said letters patent. The said invention was taken as aforesaid by the Secretary of War for use in constructing and operating the telegraph lines

for the Signal Service, authorized by Section 223 of the Revised Statutes, and at the time of such taking and use, Signal Stations at points separated by water could not conveniently, if possibly, have been constructed and operated in the form of a "suitable telegraph line" without such taking and use. The said invention was also taken and used by the Weather Bureau of the Department of Agriculture on numerous occasions.

IV. The United States never compensated the said decedent during his lifetime, nor his estate since his death, for the use of the said invention. The decedent has repeatedly petitioned Congress for such compensation and subsequent to his death his legal representative renewed the petition and a bill known as Senate 2771, 1st Session, 50th Congress, was introduced providing for relief, and this bill by resolution of the Senate of the United States was referred August 23, 1888, to this Court for findings of fact under the acts of March 3, 1883, and 1887. This court on December 4, 1916, filed its findings of fact and these were reported to the Senate on February 3, 1917, Senate Document 703, 64th Congress, 2d Session. A copy of the findings so made and reported is appended hereto as Exhibit "A."

[fol. 3] V. The Congress of the United States failed over a number of years to make any appropriation carrying into effect the findings of the Court of Claims as set forth in the preceding paragraph. In the Second Session of the Sixty-ninth Congress a bill for the relief of the plaintiff as administrator aforesaid passed the Senate but failed of passage in the House of Representatives, and in lieu thereof a private act, No. 450, approved March 3, 1927, was passed in terms as follows:

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: Provided,

That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: Provided further, That the amount of any such judgment shall not exceed the sum of $50,000: And provided further, That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States."

Plaintiff says that the facts found by this court are true and correct and that based thereon there exists a valid and just claim upon the United States in favor of the estate of [fol. 4] the decedent for fair compensation for the taking and use of the invention of plaintiff's decedent, the fair and reasonable value of which use is the sum of $50,000.

VI. No other action has been had on said claim in Congress or by any of the departments; no person other than the plaintiff is the owner thereof or interested therein; no assignment or transfer of this claim, or of any part thereof or interest therein, has been made; the plaintiff is justly entitled to the amount herein claimed from the United States, after allowing all just credits and off-sets; the plaintiff has at all times borne true allegiance to the Government of the United States and has not in any way voluntarily aided, abetted, or given encouragement to rebellion against the said Government. The plaintiff is a citizen of the United States. And the plaintiff claims $50,000.

King & King, Attorneys for Plaintiff.

Sworn to by Arthur E. Colgate, April 11, 1927.

[fols. 5-11] Exhibit "A" to petition omitted in printing. See findings of fact, page 13.

[fol. 12] II. General Traverse—Filed June 13, 1927

And now comes the Attorney General, on behalf of the United States, and answering the petition of the claimant herein, denies each and every allegation therein contained; and asks judgment that the petition be dismissed.

Herman J. Galloway, Assistant Attorney General.
Henry C. Workman, Attorney.

III. Argument and Submission

On March 5 and 6, 1928, this case was argued and submitted on merits by Mr. George A. King, for plaintiff, and by Mr. Henry C. Workman, for defendant.

[fol. 13] IV. **Special Findings of Fact, Conclusions of Law, and Opinion of the Court by Booth, Ch. J.**—Filed February 4, 1929

This case having been heard by the Court of Claims upon the findings of fact reported December 4, 1916, in Congressional case No. 6063, the court, in accord with the special act of March 3, 1927, recites said findings as follows as its

Special Findings of Fact

I

On January 31, 1848, the patentee, Simpson, filed in the Patent Office and application for a patent for "conducting electricity through water." In this application Simpson described his invention as follows:

The conducting wire was—

"first insulated with insoluble india rubber or gutta-percha; the insulated wire is then covered with glass beads (B) socketed together so as to form a close joint * * *, an soluble india-rubber tube (D) is then drawn over the glass-bead chain, jointed, cemented, and banded together (E) so as to be both water and air tight. The object of this arrangement or combination is to guard against and pre-

vent the water from coming in direct contact with the telegraphic wire, thus securing the entire control of this mysterious agent. This combination secures the object so desired."

He claimed the invention as follows:

"Now, what I claim by my invention and desire to secure by letters patent is the combination and arrangement of the gums and glass around the telegraphic wire in such form as to secure the controlling power of the mysterious agent, 'electricity,' as hereinbefore described."

Subsequently and in support of said application Simpson filed in the Patent Office a second specification "as being more explicit than the first one and as supplying the former deficiency and as embracing the whole principle of his plan for which he had asked a patent." No patent was ever issued upon this application.

[fol. 14]

II

On April 2, 1849, Simpson filed another application for a patent entitled "mode of insulating telegraph wires," in the specification of which he stated that the nature of his invention was shielding the wire from contact with any and all conducting matter—

"by covering it with india rubber, glass beads, and gutta-percha, either together or separate."

Also—

"The gutta-percha must be softened by any of the well-known processes, and when in a malleable or plastic state I spread it in any desired thickness around the wire; this operation when well and carefully done is sufficient of itself without any other coating to insulate the wire and for all ordinary practical purposes."

Also "for further security and to guard against rough usage" he specified that the wire was also covered with a coating of india rubber and with a series of glass beads, and over the beads he placed a coat of gutta-percha.

No drawing or specimen accompanied the application, but these were filed June 16, 1849, upon requisition therefor. In this application the invention claimed was—

"the application of gutta-percha as a covering or shield for wire to insulate it for electromagnetic telegraphs and also the application of india rubber, glass beads, and gutta-percha, together in the manner and for the purpose hereinbefore described.

"I do not claim the application of glass beads alone as a covering to insulate electromagnetic wires, that having been in use before my discovery. I do not claim the application of india rubber or metallic rubber alone as a covering to insulate electromagnetic wires, that having been in use before my discovery."

This application was rejected on the ground that the invention was not found new. On January 15, 1851, Simpson wrote the Commissioner of Patents relating to this application as follows:

"I herewith withdraw my application for a patent for a mode of insulating telegraph wires, now in your office, and request that $20 may be refunded to me in gold, agreeable to an act of Congress in such case made and provided."

III

December 24, 1858, Simpson filed another application for patent for "a new and improved submarine telegraph cable." The invention claimed was the combination of gutta-percha and metallic wire in such form as to encase a wire or wires or other conductors of electricity within the nonconducting substance gutta-percha.

This application was rejected on the ground that insulating electrodes with gutta-percha was well known and that the journals of France, England, and this country for several years had fully treated the subject and also on the ground that the alleged invention was abandoned to the public.

Simpson appealed from this rejection to the board of committee of appeals, and said rejection was confirmed by said committee.

[fol. 15]

IV

October 8, 1859, Simpson filed another application for patent for "submarine telegraph cable," the same in subject matter as the preceding, together with certain affidavits and exhibits in support of his claim to a patent. This application was rejected on grounds similar to those in the preceding application. Simpson again appealed to the board, who again reached their former conclusion. On May 9, 1860, the commissioner confirmed the board's decision and refused to grant a patent. Simpson then appealed to the United States Circuit Court for the District of Columbia, which overruled the appeal and confirmed the action of the Commissioner of Patents.

V

On May 4, 1866, Simpson filed another application for a patent. The specification and claim of this application were similar to those contained in the application mentioned in Finding IV. Upon this application on May 21, 1867, a patent No. 65019, and the one in controversy in this case, was issued to Simpson. The validity of this patent was sustained in the following cases: Colgate v. Western Union Telegraph Co., 15 Blatch., 365; Colgate v. Gold and Stock Telegraph Co., 16 Blatch., 503. The opinion in the above case of Colgate v. Western Union Telegraph Co. gives what was then considered by the court a complete history of the invention in question and is referred to for information upon that subject.

VI

May 12, 1848, one John J. Craven, of Newark, N. J., filed an application for patent entitled "Mode of preparing wire for electromagnetic purposes," and his claim of invention was substantially the same as the several claims of Simpson heretofore stated.

The application of gutta-percha to coating wires was disclosed in numerous printed publications and foreign patents, among which are the following:

British patent to Cooke, No. 9645, of 1842, which described a coating of india rubber as a means of insulation for telegraph wires, enrolled September 8, 1843.

British patent to Nickels, No. 10897, of 1845, which discloses the covering of wire piano strings with gutta-percha, enrolled April 27, 1846.

British patent to Brett et al., No. 11576, of 1847, which discloses the electrical insulation of metal with caoutchouc and "the substance known as vulcanized india rubber," enrolled August 11, 1847.

British patent to Reid, No. 11974, of 1847, enrolled May 23, 1848, which discloses the covering of electrical wires with gutta-percha for insulation. The third claim of this patent disclaims the use of gutta-percha for the "mere coating or covering of said electro telegraphic wires."

British patent to Barlow, et al., No. 12136, of 1848, enrolled October 27, 1848, which discloses improvements in [fol. 16] the "means of covering and thus protecting insulating wires of telegraphs when gutta-percha is used as the material or part of the material for covering such wires."

British patent to Henley, et al., No. 12236, of 1848, enrolled February 10, 1849, which discloses an "improved compound of gutta-percha suitable for the insulation covering and exterior protection of wire and other metallic substances employed to transmit currents of electricity."

It also appears that prior to the first application of Simpson for a patent for this alleged invention the matter of the insulation of telegraph wires by means of gutta-percha and other substances for several years had been the subject of much discussion in the scientific journals of Europe and particularly of Germany.

The date of enrollment of the British patents above given is the date when specifications were filed and made public.

VII

The title in the Simpson patent was in Arthur M. Eastman from March 29, 1871, until September 3, 1877, when it passed under his will to his wife, Elizabeth H. Eastman, who, on November 15, 1877, individually and as executrix, transferred the patent to Clinton G. Colgate. This transfer

of title to Colgate was a voluntary assignment and not by operation of law.

VIII

After the validity of the Simpson patent had been sustained in litigation with the Western Union Telegraph Co., as reported in that case, as before stated in fifteenth Blatchford, 365, said telegraph company entered into an agreement with the plaintiff therein whereby the sum of $100,000 was paid for all past infringements and a schedule of license fees was established for the future, and similar agreements were made with other parties desiring to use the patented invention.

IX

The United States Government has by its Signal Service and Weather Bureau used submarine cables consisting of metallic wires employed as conductors of electricity encased with gutta-percha as an insulating agent between 1873 and 1883, and by applying the rates fixed in the schedules named in the last finding the claimant would have been entitled to the sum of $50,000 for such used.

X

Considerable evidence was produced in this court relating to the priority of the invention of the device in question by said Simpson which was not before the courts in the cases heretofore mentioned, where such invention was sustained.

[fol. 17]

XI

The law in force at the time of Simpson's applications for patents was the patent act of 1836. (5 Stat. L. 117.) Section 7 of said act reads, in part, as follows:

"And be it further enacted, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examina-

tion, it shall not appear to the commissioner that the same * * * had been patented or described in any printed publication in this or any foreign country * * * it shall be his duty to issue a patent therefor."

Also the patent act of 1839 (5 Stat. L. 353). Section 6 of that act is as follows:

"Sec. 6. And be it further enacted, That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: Provided, That the same shall not have been introduced into public and common use in the United States prior to the application for such patent: And provided also, That in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent."

Conclusion of Law

Upon the foregoing special findings of fact, which are made a part of the judgment herein, the court decides, as a conclusion of law, that the plaintiff is not entitled to recover, and his petition is therefore dismissed.

Judgment is rendered against the plaintiff in favor of the United States for the cost of printing the record in this cause, the amount thereof to be entered by the clerk and collected by him according to law.

Opinion

Booth, Chief Justice, delivered the opinion of the court:

This case is governed by a special jurisdictional act approved March 3, 1927, which reads as follows:

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of

the estate of Clinton G. Colgate, deceased, against the United States, congressional, numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: Provided, That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion [fol. 18] of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: Provided further, That the amount of any such judgment shall not exceed the sum of $50,000: And provided further, That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States."

The case was before the court in 1916 upon a congressional reference, and findings of fact were made and transmitted to Congress on December 4, 1916. The special jurisdictional act expressly limits the adjudication of the case to the findings heretofore made by the court and leaves for final consideration by the court the single issue of law applicable thereto. The case itself is one of ancient origin and sui generis in many of its aspects. Simpson, the original patentee, filed his first application for a patent January 31, 1848. The application embraced but one claim and that, as appears from Finding I, was for a "combination and arrangement of the gums and glass around telegraphic wire in such form as to secure the controlling power of the mysterious agent 'electricity.'" In April, 1849, the applicant filed a new application, going more into detail and especially amplifying his invention. The applications were rejected by the Patent Office, and on January 15, 1851, the applicant wrote the letter set out at the close of Finding II. Almost eight years later, on December 24, 1858, the inventor filed another application containing without important modifications a claim for his original invention. This application was rejected on the ground of public knowledge of the alleged invention and abandonment of the same. From the order rejecting this applica-

tion the applicant unsuccessfully appealed to the board of committee of appeals. On October 8, 1859, another application was filed, containing the same subject matter, and again it met with a rejection order, predicated upon the same ground as the preceding rejection. The applicant again appealed, resulting in a confirmation of the order of rejection. The applicant then appealed to the United States Circuit Court for the District of Columbia, receiving finally a decision adverse to his contentions. On May 4, 1866, another application was filed covering again the same subject matter, and as a close to the proceedings the application was allowed and letters patent issued to the inventor on May 21, 1867. The findings disclose the subject matter of the invention; no issue arises with respect thereto.

The jurisdictional act uses these words, "to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require." Both the plaintiff and the defendant seem to be in accord with the construction of the statute, that the law applicable to the case is the statutory law in force and in existence at the time the controversy arose and continued. We think the parties are correct in this respect. Congress was fully apprised as to the facts. The existing doubt as to liability arose upon a legal point, and the plaintiff was afforded a forum and opportunity to present his contentions as to the legal liability of the defendant, and the defendant granted equal rights with respect to any available defenses.

[fol. 19] The plaintiff insists that the validity of the patent has been repeatedly established in courts of competent jurisdiction and that this issue is res adjudicata.

The original assignee of the patent, Colgate, commenced a suit in equity against the Western Union Telegraph Company to enjoin infringement of the patent herein involved in the United States Circuit Court for the Southern District of New York. (15 Blatch. 365.) Then Circuit Judge Blatchford on November 26, 1878, delivered the opinion of the court. In the opinion, a very exhaustive one, the court covered and disposed of every defense now raised by the defendant, lack of novelty, anticipation, abandonment, and alleged illegality of procedure in the Patent

Office. An injunction was granted and an accounting decreed. Subsequently the defendant paid the plaintiff $100,000 in satisfaction of past infringement and for a license for future use.

The above case, subsequently followed by additional litigation involving Simpson's patent, would, of course, in the usual course of judicial procedure, determine the issue as to validity. See also Colgate v. Western Union Telegraph Co., 19 Fed. 828; Colgate v. Gold and Stock Telegraph Co. (Federal cases #2991); United States v. Colgate, 21 Fed. 318; United States v. Colgate, 32 Fed. 624; Colgate v. International Ocean Telegraph Co. (Federal cases #2993); Colgate v. Compagnie Francaise Du Telegraphe de Paris a New York, 23 Fed. 82.

The jurisdictional act is positive in expression and devolves upon the court the necessity of adjudicating the case upon the findings made in 1916. The findings reported to the Senate in 1916 followed from a quite voluminous record, including, of course, the documents recited therein, and were not excepted to by either party subsequent to their announcement, so that they did not reflect to the satisfaction of the parties the facts of the case from the record made up during the course of the trial of the same. The court, in view of this situation, has no alternative except to take the case and adjudicate it upon the existing findings and the applicable law. The court would have little trouble in doing so were it not for the defendant's insistence upon the issue of abandonment. This, we think, is the determinative point in the case. Circuit Judge Blatchford disposed of this particular contention and predicated his conclusions upon a letter written by the inventor to the Commissioner of Patents on January 13, 1851. This letter the court reproduces, as follows:

"Please pay to the order of George B. Simpson, claimant for insulation of telegraph wire, twenty dollars balance of patent fee to be refunded on rejection of claim."

In response to a defense rested upon abandonment of application, predicated upon the foregoing letter, the court said:

"His specification of 1849 is fairly to be considered, for the purposes of this suit, as an amendment of his two

specifications of 1848, and the application of January, 1848, is to be regarded as an application completed in 1849, in such wise that the application made in January, 1848, is to be regarded as a continuous application, rejected in October, 1849. By this statute, as it stood at the latter date, the applicant, on the rejection of his application for want of novelty, which was the ground of such rejection [fol. 20] of Simpson's application, had placed before him two alternatives. One was to elect to withdraw his application, whereupon, on filing a notice, in writing, of such election, he would be entitled to receive back $20. The other was to persist in his claim for a patent, whereupon, on filing a new oath, he could take an appeal. If he did not file a notice of his election to withdraw his application, he was to be regarded as persisting in his claim for a patent. In the present case, Simpson did not file any notice of his election to withdraw his application, or any notice that he withdrew his application. He asked for the $20, without withdrawing his application, and, although the office was not authorized to pay him back the $20 unless he withdrew his application it did so. The office may have regarded the request for the $20 as equivalent to a withdrawal of the application, but the statute is distinct, and a request to be paid 'twenty dollars balance of patent fee, to be refunded on rejection of claim,' can not be construed as a withdrawal of the application, even though the $20 was refunded and accepted. The statute is plain, and the applicant may have intentionally refrained from withdrawing his application, while, if the office had informed him that the $20 would not be refunded unless he first filed a withdrawal of his application, he might have refused to file such withdrawal, lest it might prejudice his rights. He left all the papers in the patent office. According to his own statement, he had refunded to Day the $20 fourteen months before he received it back from the patent office. Therefore, when he asked the office for the $20, it must have been solely because of his need of money. There is no act or declaration of his, in connection with the refunding of the $20, that can be construed into an abandonment of his application, or of his invention."

Manifestly the court did not have before it Simpson's letter of January 15, 1851, set forth at the end of Finding

II, in which the inventor unequivocally withdraws his application. The letter was in existence and available to the defendant. As a matter of fact, the complainant's counsel stated to the defendant's counsel upon the hearing that he had found this identical letter in the Patent Office, and brought it to his attention. The failure of the defendant to incorporate it in the record is commented upon by the court in the case of Colgate v. Western Union Telegraph Co., 19 Fed. 828, as follows:

"Whether it was assumed by defendant's counsel that the fact was not of sufficient importance to be incorporated into the proofs, or whether they supposed it would be treated by the court as a conceded fact, is not material, in view of the decision and opinion of the court rendered within a few days after the hearing, by which it was plainly indicated that the fact was a material one, and was not in the proofs."

The patent statute of 1836 states in part as follows:

"In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back $20, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any [fol. 21] alteration of his specifications, he shall be required to make oath or affirmation anew, in manner as aforesaid."

The opinion of the court is obviously sound in holding that the refund of the patent fee to Simpson in pursuance of the letter of January 13, 1851, was not in accord with the statute. However, it is to be especially noted that the refund of the fee was not made by the Patent Office until, as recited in Judge Blatchford's opinion, January 21, 1851, six days after the letter of January 15, 1851, a document which unquestionably met the requirements of the act of 1836 concerning refunds. The inference, we think, is irre-

sistible that the Commissioner refused a refund under the letter of January 13, 1851, and exacted the letter of January 15, 1851, two days later, prior to the payment of the refund on January 21, 1851. The fact is indisputable that the letter of January 15, 1851, was not before Judge Blatchford, and was not incorporated in the record in the first case of Colgate v. Western Union Telegraph Co. This is fully confirmed by the proceedings for a rehearing, denied by the court in Colgate v. Western Union Telegraph Co., 19 Fed. 828 (supra).

To cite numerous authorities upon the effect of the withdrawal of an application for patent and a failure to file a new one for a period of nearly eight years, wherein during the interim the invention has become known and gone into public use, is a useless proceeding. Suffice it to say that a careful examination of the cases in the briefs discloses no single instance wherein it has not been held that a proceeding akin to the instant case has not been held fatal to the patentee upon the ground of abandonment. Prior to 1861 the patent statutes fixed no specific limitation for the prosecution of applications for patents, and the issue of abandonment was uniformly determined upon general principles, taking into consideration the diligence of the applicant and the rights of the public, and Judge Blatchford's discussion of the lack of evidence of any affirmative abandonment upon the part of Simpson, due to his distressing poverty and treatment by the Patent Office, is, without the letter of January 15, 1851, unanswerable. To hazard an opinion as to what might have been the result in the first Western Union case (Federal cases, #2995), if the letter of January 15, 1851, had been incorporated in the record, is no part of the court's present duty. It is, we think, proper to observe that an insurmountable obstacle to the plaintiff's right to recover herein exists in the letter of January 15, 1851, found by the court and conceded by all parties to be a part of the transaction, and not heretofore made the part of any record adjudicating the validity of Simpson's patent, except as commented on in the motion for a rehearing in the case decided by Judge Wallace in 1884. (19 Fed. 828.)

The court being of the opinion that the jurisdictional act exacts an adjudication of plaintiff's rights under the

existing facts, i. e., is it possible for the plaintiff to recover in view of the facts found in 1916, but which were the facts in 1851—if so, render judgment, irrespective of the statute of limitations; if not, decide accordingly—can do nothing else except dismiss the petition.

It has long since been the law, established by precedent in the case of Schillinger v. United States, 155 U. S. 163, [fol. 22] and thereafter followed without exception, "that the United States may specify the cases and contingencies in which the liability of the Government is submitted to the courts for judicial determination, and courts may not go beyond the letter of such consent." While there may be some merit in plaintiff's contention of res adjudicata, and if the case was in a position to be heard in a court of competent jurisdiction this late day the insistence would be tenable, nevertheless it is our opinion that where Congress has before it all the facts and decisions of the courts respecting the subject matter of a claim against the Government, and determines by a special act to submit the case in its then condition to this court for a judicial determination of liability, the court is without authority to do more than take the case as it finds it and reach a determination in accord with its merits under the present record of facts, especially so when the facts of the case differ materially from the facts appearing in the record involving former adjudications.

The petition will be dismissed. It is so ordered.

Sinnott, Judge; Green, Judge; Moss, Judge; and Graham, Judge, concur.

[fol. 23] V. JUDGMENT

At a Court of Claims held in the City of Washington on the 4th day of February, A. D. 1929, judgment was ordered to be entered as follows:

Upon the special findings of fact, which are made a part of the judgment herein, the court decides, as a conclusion of law, that the plaintiff is not entitled to recover, and his petition is therefore dismissed.

VI. Application for Appeal and Order Allowing Same

From the judgment rendered in the above-entitled cause on February 4, 1929, the plaintiff, Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, hereby makes application for and gives notice of an appeal to the Supreme Court of the United States, in accordance with the provision for appeal contained in the special act under which this case comes to this court, which provision is as follows:

"That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment."

(Opinion of the court, foot p. 17, top p. 18.)

King & King, Attorneys of Record for Plaintiff.

Filed April 23, 1929.

Ordered that above application for appeal be allowed by the court as prayed for.
April 26, 1929.

[fol. 24] Clerk's certificate to foregoing transcript omitted in printing.

[fol. 25] Supreme Court of the United States

Statement of Points Relied Upon by Appellant and Designation to Print Entire Record—Filed May 2, 1929

The appellant contends that the Court of Claims erred in dismissing his petition and in not awarding a money judgment for $50,000, and in support of that contention relies upon the following points:

1. The patent herein involved was sustained by the United States Circuit Court for the Southern District of New York in no less than nine different reported decisions cited in

either Finding V or in the opinion of the court, some of them in a case in which the United States sued Colgate, the intestate whom the present administrator represents, to cancel the patent, and the Court of Claims erred in not following the decisions of said United States Circuit Court as constituting authoritative decisions in favor of the validity of the patent herein sued on, and especially in not giving full effect to the decree of said Circuit Court in the action brought by the United States against Colgate to cancel the patent.

2. Said Court of Claims also erred in holding that the letter withdrawing the application for patent and requesting the Commissioner of Patents to refund the fee of $20 [fols. 26 & 27] invalidated a continuation and renewal of the application for patent and invalidated the patent issued thereon.

3. The Court of Claims erred in failing to carry out the intent of Congress in the passage of the special act of March 3, 1927, and in dismissing the petition, and in not rendering judgment for $50,000, as required by said act.

The appellant, in pursuance of Rule 9, designates the entire record filed herein for printing.

George A. King, George A. King, C. Bascom Slemp, C. Bascom Slemp, Louis Titus, Louis Titus, Attorneys for Appellant. A. A. Wheat, Acting Solicitor General.

May 2, 1929.

[fol. 28] [File endorsement omitted.]

Endorsed on cover: File No. 34,178. Court of Claims. Term No. 869. Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, appellant, vs. The United States. Filed May 1st, 1929. File No. 34,178.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1928.

No. 74

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased, Petitioner,

v.

THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CLAIMS.

GEORGE A. KING,
C. BASCOM SLEMP,
LOUIS TITUS,
Attorneys for Petitioner.

(34,178)

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1928.

No. 869.

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE OF CLINTON G. COLGATE, DECEASED, Petitioner,

v.

THE UNITED STATES.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CLAIMS.

To the Honorable the Supreme Court of the United States:

The petition of Arthur E. Colgate, Administrator of the Estate of Clinton G. Colgate, deceased, respectfully represents:

Your petitioner prays for a writ of certiorari to review a final judgment of the Court of Claims of the United States, rendered in this case on February 4, 1929, dismissing a petition of the petitioner praying

for a judgment in the sum of $50,000 against the United States, the claim against the United States arising out of the use by the United States, without a license, of a certain patented device for insulating submarine cables, which belonged to the estate of Clinton G. Colgate, deceased.

On March 3, 1927, Congress passed an act which reads as follows (44 Stat., Part III, p. 1807):

> "CHAP. 408.—*An Act for the Relief of Arthur E. Colgate, Administrator of Clinton G. Colgate, Deceased.*
>
> "*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: *Provided,* That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: *Provided further,* That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further,* That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall

be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States."

"Approved, March 3, 1927."

In pursuance of this act, petitioner filed his petition in the Court of Claims on May 4, 1927. As appears by the above act, the case had been previously before the Court of Claims, and that court had made and reported to Congress its Findings of Fact in said case. On February 4, 1929, the Court of Claims entered the same Findings of Fact as it had previously reported to Congress, and thereupon entered a judgment dismissing the petition.

These findings show that, beginning in 1848, George B. Simpson filed in the Patent Office a number of successive applications for patent for a device for insulating submarine cables by a covering of gutta-percha. These applications continued at intervals until 1866, when the final application was filed upon which the patent was issued May 21, 1867.

On January 15, 1851, Simpson wrote the Commissioner of Patents a letter withdrawing his application for patent and requesting the refund of his fee of $20. He renewed the application December 24, 1858, for substantially the same invention. After many further rejections and new applications the patent was finally issued May 21, 1867.

By mesne conveyances title to the Simpson patents became vested November 15, 1877, in Clinton G. Colgate, the intestate of the present petitioner (Finding VII).

Two decisions of the United States Circuit Court for the Southern District of New York are by reference made a part of Finding V—*Colgate* v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case No. 2995, and *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case No. 2991. Both of these decisions are by Circuit Judge, later Mr. Justice, Blatchford, and elaborately discuss the history of the invention and its progress through the Patent Office, as well as the prior state of the art. These unequivocally upheld the patent in question and awarded an injunction and damages against the two corporations, respectively, involved.

There are two later opinions reported in the case against the Western Union Telegraph Company, one, Fed. Case No. 2994, decided October 27, 1879, also by Judge Blatchford, granting an attachment for violation of the injunction, the other, in 19 Fed. 828, decided April 4, 1884, by Circuit Judge Wallace, being a petition for rehearing on the ground of a newly discovered letter of January 15, 1851, withdrawing the application for patent and requesting refund of the fee of $20. This petition was denied on the ground, among others, that the existence of such letter was known at the time of the argument before Judge Blatchford in 1878.

In addition to the decision of Judge Blatchford of July 22, 1879, in *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case No. 2991, he also, in Fed. Case No. 2992, decided October 27, 1879, granted an attachment against the company and its president for violation of the decree.

The patent was also sustained in *Colgate* v. *International Ocean Telegraph Co.*, 17 Blatchford, 308, Fed. Case No. 2993, decided November 15, 1879, by Judge Blatchford, and in *Colgate* v. *Compagnie Francaise du de Paris a New York*, 23 Fed. 82, decided January 30, 1885, by Circuit Judge Wallace.

The United States then brought a suit to cancel the patent, *United States* v. *Colgate*, 21 Fed. 318, decided August 9, 1884, by District Judge Wheeler, in which he denied a preliminary motion to restrain Colgate from prosecuting suits for infringement, and finally in the same cause (32 Fed. 624), decided December 11, 1884, Circuit Judge Wallace, on hearing on demurrer, the demurrer was sustained and the bill dismissed.

In all these cases the validity of the patent was upheld.

After the decision against the Western Union Telegraph Co., the company paid $100,000 for all past infringements and a schedule of license fees was established for the future, and similar agreements were made with other parties desiring to use the patented invention (Finding VIII).

The Government by its Signal Service and Weather Bureau has used submarine cables consisting of metallic wires employed as conductors of electricity encased with gutta-percha as an insulating agent between 1873 and 1883, and by applying the rates fixed in the schedules named above the claimant would have been entitled to $50,000 for such use (Finding IX).

On these findings the Court of Claims held:

1. The repeated decisions sustaining the validity of this patent would be conclusive on the court on the same state of facts presented to the United States Circuit Court for the Southern District of New York.

2. As, however, the letter of January 15, 1851, withdrawing the application and requesting refund of the fee of $20 was not before Judge Blatchford at the time of his decisions in 1878 and 1879, but only the letter of January 13, 1851, which requested a refund of the $20 without withdrawing the application, they held that the withdrawal of the application by letter of January 15, 1851, constituted a fatal bar to the validity of the patent or to the maintenance of this claim, and therefore dismissed the petition.

Your petitioner therefore prays for the issuance of a writ of certiorari to review the judgment of the Court of Claims on the following grounds:

1. The act of Congress directs the Court of Claims "to render judgment as the findings of fact heretofore found and the law require." It also provides for an appeal to this Court. This last provision indicates the intent of Congress that there should be a review by this Court. If not allowable by appeal, it should be granted by writ of certiorari.

2. The patent herein involved was sustained by the United States Circuit Court for the Southern District of New York in every suit in which its validity was brought in question. These suits were all by Clinton

G. Colgate, the intestate under whom petitioner claims. All of them were against corporate infringers with the exception of one, which was by the United States as plaintiff against Colgate to cancel the patent. In all of them Colgate prevailed.

The judgment of the Court of Claims in this case is the first and only decision of any Federal court against the validity of the patent. This creates a conflict of decision between Federal courts on the same patent which should be settled by this Court.

A question of public interest is involved, because it is always to the public interest that the United States should pay its just obligations, that an act of Congress providing for the examination and recognition of such obligations should have full force and effect, and that the validity and construction of patent rights by the courts of the United States should be uniform.

The opinion and judgment of the Court of Claims are in conflict with the principles of *stare decisis* in failing to follow the decisions of the Circuit Court of the United States for the Southern District of New York in upholding the patent in suits by Colgate against various corporate infringers. It is also in conflict with the principle of *res judicata* in failing to give full force and effect to the decision of said United States Circuit Court in the suit against Colgate to cancel the patent, which suit was on demurrer thereto dismissed.

4. The decision of the Court of Claims holding that the letter withdrawing the application for patent and

requesting the Commissioner of Patents to refund the fee of $20 invalidates the patent is a departure from settled principles of the law of patents as laid down by this court, to wit, in *Godfrey* v. *Eames,* 1 Wallace, 317; *Overland Motor Co.* v. *Packard Motor Co.,* 274 U. S. 417, and other cases.

GEORGE A. KING,
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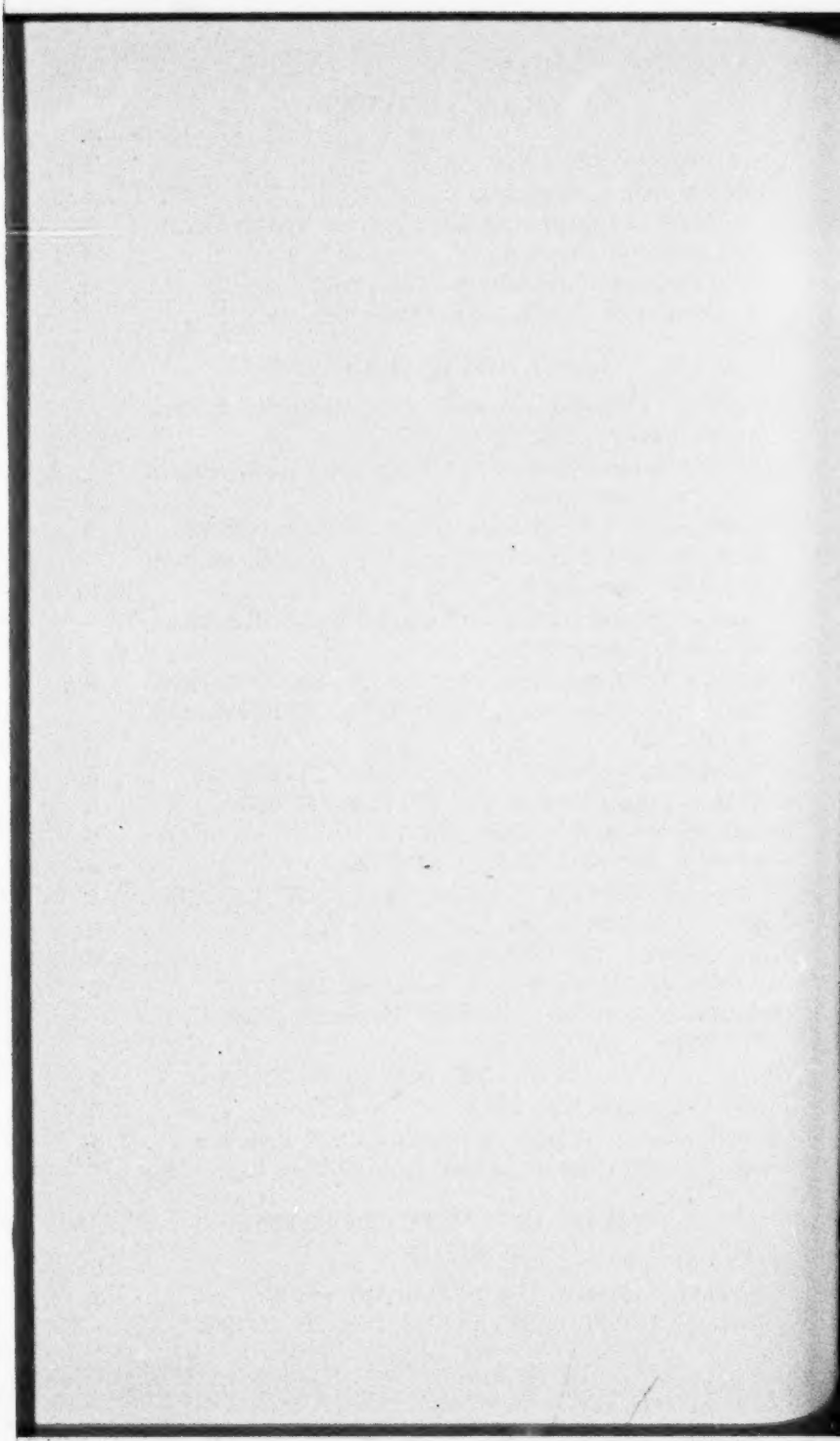

Supreme Court of the United States.

October Term, 1928.

ARTHUR E. COLGATE, Administrator of the Estate of CLINTON G. COLGATE, Deceased, *Petitioner*,
v.
THE UNITED STATES.

No. 869.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

This case came before the Court of Claims by virtue of the following act (44 Stat. Part III, p. 1807):

"Chap. 408. An Act for the relief of Arthur E. Colgate, administrator of Clinton G. Colgate, deceased.

"*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: *Provided*, That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment; *Provided further*, That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further*, That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States.

"Approved, March 3, 1927."

The Court of Claims made findings of fact (R. 4–10) identical with those previously entered under the Congressional reference referred to in the special act, the reference having been under the terms of the Bowman Act, March 3, 1883, c. 116, 22 Stat. 485, sec. 1, "An Act to afford assistance and relief to Congress and the executive departments in the investigation of claims and demands against the government."

The validity of the patent had been sustained in a large number of suits, two of which are referred to in Finding V, *Colgate* v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case #2995, and *Colgate* v. *Gold and Stock Telegraph Co.*, 16 Blatchford, 503, Fed. Case #2991 (R. 7). Others are referred to in the opinion of the court (R. 13). One of them was an unsuccessful suit brought directly by the United States against Colgate to repeal the patent, *United States* v. *Colgate*, 22 Blatch. 412, 21 Fed. 318, 32 Fed. 624, 127 U. S. 792.

The Court of Claims concedes that the case would be governed by these decisions but for a letter of Simpson, the original inventor, dated January 15, 1851, to the Commissioner of Patents, withdrawing his application for patent. On this sole ground the Court of Claims decides against the claim and dismisses the petition (R. 13–16).

It appears, however, by a subsequent decision, April 4, 1884, in the same case against the Western Union Telegraph Company, 22 Blatch. 118, 19 Fed. 828, decided by Circuit Judge Wallace, that this same letter was presented to him in the same court and in the same case in support of an application for rehearing of the case, and that he refused the rehearing on the very ground, among others, that the letter was known to counsel at the time of Judge Blatchford's original decision in Colgate's case against the telegraph company in 1878. (See quotation from Judge Wallace's opinion in the opinion of the Court of Claims, R. 15.)

At a still later date, December 11, 1884, the U. S. Circuit Court, by Judge Wallace, dismissed on demurrer a bill by the United States to cancel the patent. *United States* v. *Colgate*, 32 Fed. 624. This was at a time when the existence of this letter of abandonment was well known.

The following are the reported decisions of that court as

referred to either in Finding V (R. 7) or in the opinion of the court (R. 13), or both.

Colgate v. *Western Union Telegraph Co.*, 15 Blatchford, 365, Fed. Case #2995, decided November 26, 1878: Full discussion of patent by Judge Blatchford; invention sustained against alleged anticipation; also holding it infringed by the Western Union Telegraph Company and decreeing that the plaintiff have an injunction and an accounting with costs.

Colgate v. *Gold and Stock Telegraph Co.*, 16 Blatch. 503, Fed. Case #2991, decided July 22, 1879, by Blatchford, Circuit Judge, again sustained validity of patent, with particular reference to newly introduced German publications of 1847; holding that Simpson was the first inventor and that Colgate as his assignee is entitled to an injunction and accounting.

Colgate v. *Western Union Telegraph Co.*, Fed. Case #2994, decided October 27, 1879, by Blatchford, Circuit Judge; motion for attachment for violation of injunction previously decreed granted.

Colgate v. *Gold and Stock Telegraph Co.*, Fed. Case #2992, decided October 27, 1879, by Blatchford, Circuit Judge: Attachment for violation in preceding case (Fed. Case #2991) granted against the company and its president.

Colgate v. *International Ocean Telegraph Co.*, 17 Blatch. 308, Fed. Case #2993, decided November 15, 1879, by Blatchford, Circuit Judge: Validity of patent sustained. Held infringed by international cable between the shores of Florida and Cuba. Injunction and accounting granted.

Colgate v. *Western Union Telegraph Co.*, 22 Blatch. 118, 19 Fed. 828, decided April 4, 1884, by Wallace, Circuit Judge: Petition for rehearing on the ground of newly discovered letter of January 15, 1851, showing withdrawal of application for patent, denied on the ground, among others, that the existence of such letter was known to counsel for both parties at the time of the hearing before Judge Blatchford in 1878.

United States v. *Colgate*, 22 Blatch. 412, 21 Fed. 318, decided August 9, 1884, by Wheeler, District Judge: Bill by the United States to repeal the Simpson patent. Preliminary motion to restrain Colgate from prosecuting suits for infringement denied.

United States v. Colgate, 32 Fed. 624, decided December 11, 1884, by Wallace, Circuit Judge: Same suit on hearing on demurrer to bill. Demurrer sustained and bill dismissed unless within twenty days the United States moves to amend, which was not done and the bill was therefore dismissed.

Colgate v. *Compagnie Francaise Du Telegraphe De Paris a New York*, 23 Fed. 82, decided January 30, 1885, by Wallace, Circuit Judge: Bill for infringment of Simpson patent again sustained.

United States v. *Colgate*, 127 U. S. 792, appeal from decree of dismissal of bill to repeal the Simpson patent, 32 Fed. 624. Appeal dismissed by the Solicitor General April 2, 1888.

(This appeal is not mentioned in the findings or opinion of the Court of Claims.)

Thus decisions were rendered in favor of Colgate both in his own suit against the Western Union Telegraph Company and in a suit brought by the United States against Colgate to repeal the patent after the existence of the letter of January 15, 1851, had become known.

The Court of Claims, however, held that the existence of that letter of withdrawal was fatal to the validity of the patent and to the maintenance of this claim against the United States and thus dismissed the petition (R. 16).

Grounds for Certiorari.

1. *Intent of Congress to Allow Review by This Court.*

The act of Congress directs the Court of Claims "to render judgment as the findings of fact heretofore found and the law require." It also provides for an appeal to this court. This last provision indicates the intent of Congress that there should be a review by this court. If not allowable by appeal, it should be granted by writ of certiorari.

2. *Conflict of Decision.*

The conflict of decision between the United States Circuit Court for the Southern District of New York and the Court of Claims in the present case is alone sufficient to warrant the issuance of a writ of certiorari.

Here, in no less than nine reported cases of the Circuit Court of the United States for the Southern District of New York, Finding V (R. 7) and opinion (R. 13), summarized, *ante*, pp. 2, 3, 4, that court sustained the validity of the Simpson patent and the title of Colgate thereto.

These decisions were rendered by Circuit Judge Blatchford, later a Justice of this court, Circuit Judge Wallace, and District Judge Wheeler. Two of them were rendered in a suit by the United States directly against Colgate to repeal the patent. The existence of Simpson's letter of January 15, 1851, withdrawing his application for patent was certainly known in the later stages of the litigation. According to Judge Wallace's decision of April 4, 1884, 19 Fed. 828, it was also known to counsel for both parties at the time of the original hearing before Judge Blatchford in 1878.

Examination of the transcript of record on the appeal in *United States* v. *Colgate*, 127 U. S. 792, shows that Simpson's letter of January, 1851, withdrawing his patent was set up in the bill of complaint of the United States (p. 6 of printed record in No. 198, October Term, 1887).

A conflict between nine decisions of the Circuit Court of the United States for the Southern District of New York, all holding one way, and the decision of the Court of Claims in the present case, holding the other way, on the same patent presents the strongest possible ground for the issuance of a writ of certiorari to correct such a glaring contradiction in decisions.

This is a recognized ground for review of patent cases by this court on writ of certiorari as shown by the following recent cases: *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 179; *Milburn Co.* v. *Davis Co.*, 270 U. S. 390, 399; *Temco Co.* v. *Apco Co.*, 275 U. S. 319, 322; *Corona* v. *Dovan Corporation*, 276 U. S. 358, 365 and *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245, 247.

During the entire time covered by the decisions referred to—1878 to 1888—an appeal lay directly from a United States Circuit Court to this court. Revised Statutes, Sec. 699, paragraph First, in force at the time, provides for an appeal "from any final decree in equity, without regard to the sum or value in dispute" "in any case touching patents-rights or copy-

rights." Thus, any of the numerous infringers against whom Colgate obtained decrees was free to appeal to this court, but none did so. The United States did appeal from the decree of dismissal but this appeal was dismissed, 127 U. S. 792.

3. *Question of Public Interest Involved.*

A question of public interest is involved, because it is always to the public interest that the United States should pay its just obligations, that an act of Congress providing for the examination and recognition of such obligations should have full force and effect, and that the validity and construction of patent rights by the courts of the United States should be uniform.

The judgment of the Court of Claims is in conflict with the principle of *stare decisis* in failing to follow the decisions of the Circuit Court of the United States for the Southern District of New York in upholding the patent in suits by Colgate against various corporate infringers. It is also in conflict with the principle of *res judicata* in failing to give full force and effect to the decisions of said United States Circuit Court in the suit against Colgate to cancel the patent, which suit was on demurrer thereto dismissed.

This was a suit commenced by the United States against Colgate, to cancel the patent on the ground that there was no novelty in the invention and that the invention was publicly known long prior to the issuance of the patent. Thus the suit to cancel the patent by the United States was based upon the identical ground upon which the Court of Claims in the present case held that the patent was invalid. A general demurrer was sustained to the bill with leave to the United States to amend within twenty days. The United States did not choose to amend and a decree was entered, dismissing the bill.

This was a decree on the merits, establishing the validity of the patent. *Durant* v. *Essex*, 7 Wall. 107; *Lyon* v. *Perrin*, 125 U. S. 698; *Hickey* v. *Johnson*, 9 Fed. (2d) 498. From this decree the United States took an appeal to the Supreme Court of the United States. This appeal was dismissed on motion of the Solicitor General, 127 U. S. 792.

The validity of the patent, as between the United States and Colgate, was, therefore, *res judicata* and not open to further question by the United States. The Court of Claims was thus in error in holding that the United States could again inquire into the validity of the patent.

4. *Decision in Conflict with Declared Law.*

The decision of the Court of Claims holding that the letter withdrawing the application for patent and requesting the Commissioner of Patents to refund the fee of $20 invalidates the patent is a departure from settled principles of the law of patents as laid down by this court.

In *Godfrey* v. *Eames*, 1 Wallace, 317, 325:

"In our judgment, if a party choose to withdraw his application for a patent and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law."

The above decision was thus construed and applied in *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 500:

"It is impossible, in view of these facts, to regard the effort to obtain a new patent in 1864 as a new and independent application, disconnected from the application made in 1855. It was but one stage in a continuous effort. In *Godfrey* v. *Eames*, 1 Wall. 317, the first application was actually withdrawn, and a new petition was presented at the time of the withdrawal, with a different description of the invention; but as the thing patented under the second might have been engrafted as an amendment of the first, it was ruled that all the proceedings constituted one application."

The same principle was reaffirmed as late as 1927 in *Overland Motor Co.* v. *Packard Motor Co.*, 274 U. S. 417, 421, 422, opinion by the present Chief Justice:

"As the Patent Office by granting the patent must be held to have waived any objection to the application on the ground that the claim allowed had been rejected before by that Office,

there is no reason why the appellees below should not be allowed to avail themselves of the waiver. We answer the first question in the negative.

"Second. The second question was as follows:

"'In the absence of any other excuse for lapse of time between Patent Office actions and responses thereto, than that the applicant was exercising a statutory right (R. S. Sec. 4894 as amended setting limit of one year for response), may the bill of complaint be dismissed for want of equity because of long pendency in the Patent Office?'

"We think that under the decision of this court in *United States* v. *American Bell Telephone Company*, 167 U. S. 224, and *Chapman* v. *Wintroath*, 252 U. S. 126, this question must also be answered in the negative."

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Supreme Court of the United States.

October Term, 1928.

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased, *Appellant*,
v.
THE UNITED STATES.

No. [illegible]

Statement in Support of Jurisdiction on Appeal.

GEORGE A. KING,
C. BASCOM SLEMP,
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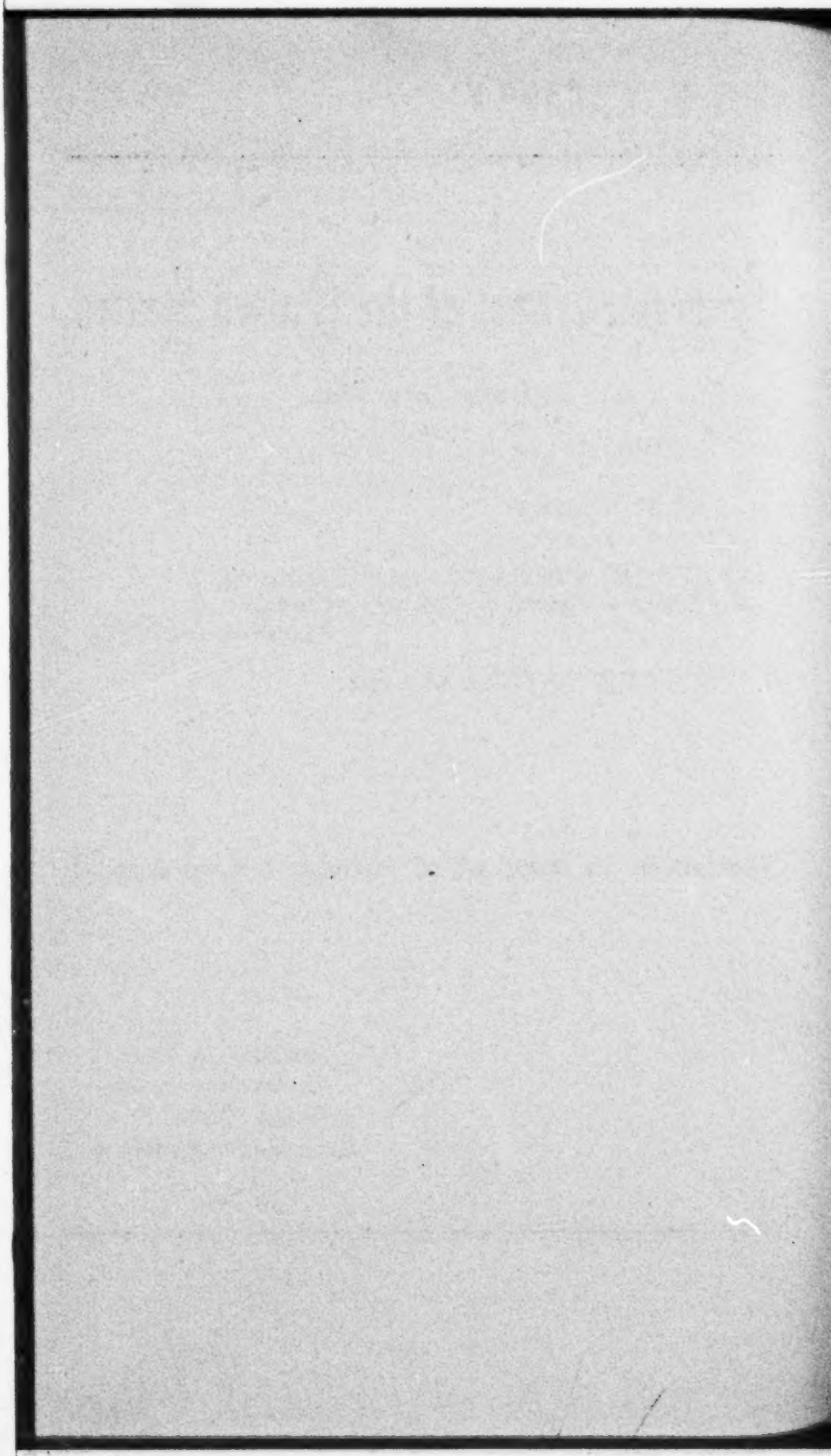

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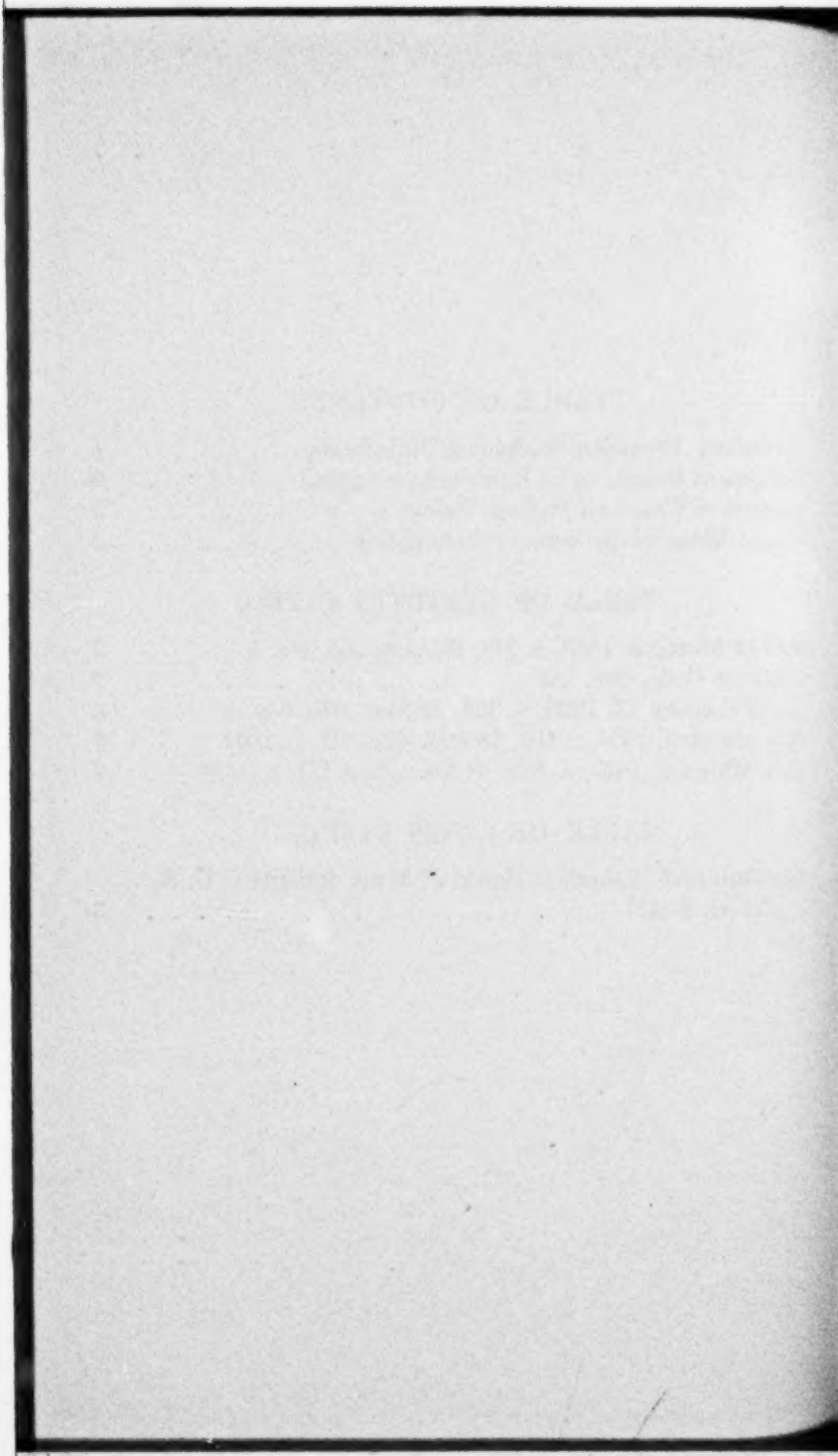

Supreme Court of the United States.

October Term, 1928.

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased, *Appellant*, v. THE UNITED STATES. | No. 869.

STATEMENT IN SUPPORT OF JURISDICTION ON APPEAL.

Statutory Provision Sustaining Jurisdiction.

The provision believed to sustain the jurisdiction of this court on appeal is that contained in the first proviso of the following act (44 Stat. Part III, p. 1807):

"Chap. 408. An Act For the relief of Arthur E. Colgate, administrator of Clinton G. Colgate, deceased.

"*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require: *Provided*, That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: *Provided further*, That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further*, That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General

to cause one of his assistants to appear and defend for the United States.

"Approved, March 3, 1927."

Judgment Sought to be Reviewed on Appeal.

The judgment sought to be reviewed was rendered February 4, 1929, and dismissed the petition of the appellant, claiming a judgment of $50,000 against the United States. (R. 17.) Application for appeal was presented to the Court of Claims April 23, 1929, and was allowed by the Court April 26, 1929 (R. 18).

Nature of Case and Rulings Below.

The claim was for the use of a patented invention by the United States. It had come before the Court of Claims by reference under the Bowman Act of March 3, 1883, c. 116, 22 Stat. 485, Sec. 1, "An Act to afford assistance and relief to Congress and the executive departments in the investigation of claims and demands against the government."

The ruling of the court below was adverse to the validity of the patent on the ground that although it had been sustained in a number of different suits referred to partly in Finding V (R. 7) and partly in the opinion (R. 13), a letter of the original inventor withdrawing his application was fatal to the renewal of the application and to the validity of the patent issued thereunder. This raises a question of law reviewable by this court.

Cases Believed to Sustain Jurisdiction.

The word "appeal" when used in legislation relative to the appellate jurisdiction of this court is always used in contradistinction to a writ of certiorari.

The fact that the length of time, ninety days, is that fixed by the old law, Judicial Code, Section 242, and not the three months allowed by the act of February 13, 1925, c. 229, 43 Stat. 936, Sec. 8, for a writ of certiorari, shows that it was the old right of appeal and not the new right obtained by a writ

of certiorari which Congress was conferring by the special act.

A similar special act allowing an appeal, approved March 4, 1927, was so construed by this court. In *Sisseton and Wahpeton Bands of Sioux Indians* v. *United States*, 277 U. S. 424, the act provided:

"That the plaintiffs or complainants in suit numbered 33371 in the Court of Claims of the United States be, and they are hereby, granted one year within which to appeal from any and all orders, judgments or decrees rendered against them in the trial of said action heretofore had:" (44 Stat. Part III, p. 1847).

This court said, 277 U. S. 427:

"The present appeal was taken under Act of Congress approved March 4, 1927, c. 522, 44 Stat. Part III, p. 1847. It specifically granted to appellants one year from date within which to appeal and was intended, we think, to confer a right of appeal as distinguished from the right to petition for certiorari within three months of the judgment, conferred by sections 3 and 8 of the jurisdictional Act of February 13, 1925."

The appeal in that case, it is true, was by legislation enacted after the judgment of the Court of Claims, while here it was by an act passed before judgment. The distinction, it is submitted, is not material.

For greater caution a petition for a writ of certiorari has also been filed, in support of which a separate brief is presented contemporaneously with this Statement in Support of Jurisdiction on Appeal.

GEORGE A. KING,
C. BASCOM SLEMP,
LOUIS TITUS,
Attorneys for Appellant.

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IN THE

Supreme Court of the United States.

October Term, 1929.

ARTHUR E. COLGATE, Administrator of the Estate of Clinton G. Colgate, Deceased, *Petitioner*,
v.
THE UNITED STATES.

No. 74.

REPLY BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

GEORGE A. KING,
C. BASCOM SLEMP,
LOUIS TITUS,
Attorneys for Petitioner.

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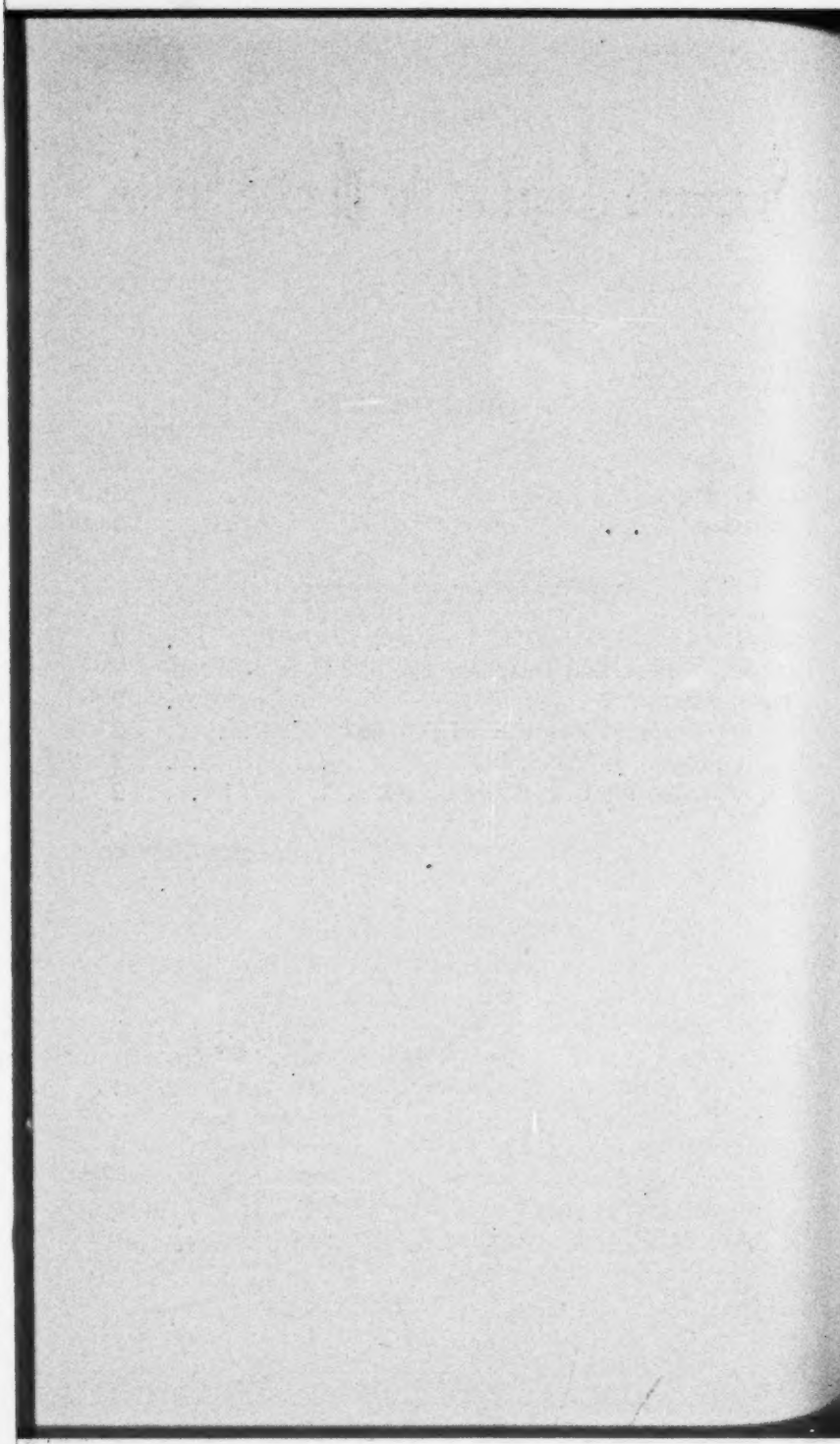

IN THE

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No. 74.

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The brief for the United States throws into strong relief the extent to which the decision of the Court of Claims contradicts the two important principles of *stare decisis* and *res judicata*.

1. *Stare Decisis.*

The many suits brought by Colgate against powerful and important infringers are enumerated in our brief in support of this petition, pp. 3, 4. Every one of them was decided in favor of Colgate after earnest contestation of the validity of the patent. No appeals were taken and the decrees were submitted to by these powerful infringers.

The proposition that decrees repeatedly sustaining the validity of a patent and holding the infringers liable in damages can thereafter be assailed without bringing anything forward to discredit them beyond objections already considered and overruled by the court which rendered the decision is, to say the least, startling. It would not be permitted in private infringement litigation over a patent. Why should a different rule apply when the United States is the infringer?

2. *Res Judicata.*

The two cases of *United States* v. *American Bell Telephone Company*, 128 U. S. 315, 159 U. S. 548, 555, cited in the brief for the United States, p. 15, place the right of the United States to maintain a bill in equity to repeal a patent for an invention on the same ground as the right to maintain such a suit to repeal a land patent. No distinction is taken between the two. When the United States came into court as a litigant it set up this identical letter of January, 1851, withdrawing the application for patent as a ground for asking the Circuit Court to repeal the patent. Two opinions were delivered in that case, one denying the motion for a preliminary injunction, the other dismissing the bill on its merits on demurrer, *United States* v. *Colgate*, 21 Fed. 318, 32 Fed. 624. Judge Wallace, in the latter of these two opinions, while not specifically mentioning this letter of withdrawal had it before him and necessarily held it insufficient to warrant a finding that the patent had been improperly issued.

A decree or judgment in a suit to which the United States is a party is conclusive in future litigation between the same parties. It was so held where the prior judgment was *in favor* of the United States, *Hubbell* v. *United States*, 171 U. S. 203, 207, 208. It was equally applied to a case where the prior judgment had been *against* the United States, *United States* v. *Moser*, 266 U. S. 236, 241, 242. It must necessarily apply in this case where the Government sets up and has so far succeeded in maintaining a defense many years ago discredited and overruled by the very court in which the Government itself sought relief. This decree was found to be so incapable of being successfully assailed that the highest law officers of the Government abandoned and dismissed their appeal in this court, *United States* v. *Colgate*, 127 U. S. 792. The decree thereby became forever binding and conclusive on the United States in all cases thereafter arising affecting the validity of this patent.

CONCLUSION.

In addition to being a case where there are conflicting de-

cisions in different courts on the validity of the same patent, the present case is one in which the court below "has so far departed from the accepted and usual course of judicial proceedings" "as to call for an exercise of this court's power of supervision" (Rule 38, Par. 5 (b)).

GEORGE A. KING,
C. BASCOM SLEMP,
LOUIS TITUS,
Attorneys for Petitioner.

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No. 74

In the Supreme Court of the United States

OCTOBER TERM, 1929

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE OF CLINTON G. COLGATE, DECEASED, APPELLANT

v.

THE UNITED STATES

APPEAL FROM THE COURT OF CLAIMS

JURISDICTIONAL STATEMENT OF APPELLEE

U. S. GOVERNMENT PRINTING OFFICE: 1929

In the Supreme Court of the United States

OCTOBER TERM, 1929

No. 74

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE of Clinton G. Colgate, deceased, appellant

v.

THE UNITED STATES

APPEAL FROM THE COURT OF CLAIMS

JURISDICTIONAL STATEMENT OF APPELLEE

The question presented is whether the proper method of reviewing the judgment of the Court of Claims is by appeal or on writ of certiorari.

Arthur E. Colgate, as administrator of the estate of Clinton G. Colgate, deceased, has taken this appeal in due time. He has also filed a petition for certiorari, which is now pending. We submit that the latter is the only method provided by law for a review of the judgment in this case, and that this appeal should be dismissed.

The statute which it is asserted confers upon this Court appellate jurisdiction as of right is the Act

of March 3, 1927 (c. 408, 44 Stat., Part III, p. 1807), quoted in full in the appellant's Statement in Support of Jurisdiction. The provision here material reads as follows:

> *Provided,* That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment.

This statute was enacted subsequent to the Act of February 13, 1925, amending the Judicial Code (c. 229, 43 Stat. 936), which abolished generally appeals from the Court of Claims and provided that all judgments of that court should be reviewed by certiorari or certificate, and not otherwise. It is submitted, however, that the above-quoted language of the statute here in question is not sufficient to show an intention on the part of Congress that special treatment should be accorded to this claim or that the judgment upon it should be reviewed otherwise than in accordance with the Act of February 13, 1925.

The phrase " from any conclusion of law or judgment, from which appeals now lie in other cases," strongly supports this position. No "appeal," as distinguished from an application for a writ of certiorari, would "now (i. e., on March 3, 1927) lie in other cases" from a judgment such as that here involved. The last-quoted phrase tends strongly to

show that the word "appeal," as earlier used in the proviso, should be construed in its broad and popular sense, as meaning a review by this Court in accordance with the applicable general statute providing and limiting the method of such review. Even apart from this phrase, however, we believe that such would be its correct construction.

In *Sisseton and Wahpeton Bands of Sioux Indians* v. *United States*, 277 U. S. 424, cited by appellant, an entirely different situation was presented. In that case the original jurisdiction Act was passed prior to the Act of February 13, 1925, and provided, as was customary, for a right of appeal to this Court. Judgment went against the claimants in the Court of Claims, and their right of appeal was lost by failure to apply for it in time. Thereafter the Act of February 13, 1925, was passed, and later still Congress passed another Act reviving the right of appeal from the judgment of the Court of Claims and granting to the claimants one year in which to take it. In view of these circumstances, this Court held that the statute conferred a right of appeal as distinguished from the right to petition for certiorari.

The Act involved in the *Sisseton and Wahpeton Bands case* was passed after the judgment in the Court of Claims and had reference only to the review of that judgment by this Court. The purpose of the Act here involved is primarily to confer jurisdiction on the Court of Claims.

Since the Act of February 13, 1925, a number of jurisdictional Acts in Indian cases have been passed in which Congress has used the phrase "with right of appeal to the Supreme Court of the United States," sometimes with the addition of the phrase "as in other cases." This was the language customarily employed before the Act of February 13, 1925.

The following is a list of the later Acts, together with the wording of the pertinent provisions:

Act of March 3, 1925 (c. 459, 43 Stat. 1133, 1134), Kansas or Kaw Indians:

> From the decision of the Court of Claims * * * an appeal may be taken by either party as in other cases to the Supreme Court of the United States.

Act of May 14, 1926 (c. 300, 44 Stat. 555), Chippewas of Minnesota:

> With right of appeal to the Supreme Court of the United States by either party as in other cases.

Act of July 2, 1926 (c. 724, 44 Stat. 801), Citizen Band of Pottawatomies:

> With the right of appeal to the Supreme Court of the United States by either party as in other cases.

Act of July 3, 1926 (c. 734, 44 Stat. 807), Crow Indians:

> With right of appeal to the Supreme Court of the United States by either party.

Act of March 2, 1927 (c. 250, 44 Stat. 1263), Assiniboine Indians:

> With right of appeal to the Supreme Court of the United States by either party.

Act of March 3, 1927 (c. 302, 44 Stat. 1349), Shoshone Indians:

> With right of appeal to the Supreme Court of the United States by either party.

Act of May 18, 1928 (c. 624, 45 Stat. 602), Indians of California:

> With the right of either party to appeal to the Supreme Court of the United States.

Act of December 17, 1928 (Public No. 638, 70th Congress), Winnebago tribe:

> With the right of appeal to the Supreme Court of the United States by either party as in other cases.

Act of February 20, 1929 (Public No. 783, 70th Congress), Nez Perce tribe:

> With the right of appeal by either party to the Supreme Court of the United States.

Act of February 23, 1929 (Public No. 798, 70th Congress), Coos (Kowes) Bay, Lower Umpqua and Siuslaw tribes:

> And the right of appeal to the Supreme Court of the United States is hereby granted to both parties.

Act of February 28, 1929 (Public No. 854, 70th Congress), Shoshone tribe:

> That from the decision of the Court of Claims in any suit prosecuted under the authority of this Act an appeal may be taken by either party, as in other cases, to the Supreme Court of the United States.

It is not reasonable to suppose that Congress, after having passed the Act of February 13, 1925, for the purpose of relieving this Court of the burden of appeals as of right from the Court of Claims, and from other courts, intended by such special jurisdictional Acts as those above enumerated, and as the Act involved in this case, to confer upon the claimants the right of appeal regardless of its merit or the importance of the questions involved. Such an intention should not be implied from the general language employed in those Acts. And in the particular Act involved in this case the phrase "from which appeals now lie in other cases" affirmatively indicates a contrary intention.

It is respectfully submitted that this Court is without jurisdiction to entertain this appeal.

CHARLES E. HUGHES, JR.,
Solicitor General.
HERMAN J. GALLOWAY,
Assistant Attorney General.
WILLIAM J. HUGHES,
Attorney.

JUNE, 1929.

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No. 74

In the Supreme Court of the United States

OCTOBER TERM, 1929

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE OF CLINTON G. COLGATE, DECEASED, PETITIONER

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

U.S. GOVERNMENT PRINTING OFFICE : 1929

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In the Supreme Court of the United States

OCTOBER TERM, 1929

No. 74

ARTHUR E. COLGATE, ADMINISTRATOR OF THE ESTATE of Clinton G. Colgate, Deceased, petitioner

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

OPINION BELOW

The opinion of the Court of Claims (R. 10–17) is not yet reported.

JURISDICTION

The judgment of the Court of Claims was entered on February 4, 1929. (R. 17.) The petition for writ of certoriari was filed May 1, 1929. (R. 19.) The Government contends that the only jurisdiction in this Court to review this judgment is under Section 3(b) of the Act of February 13, 1925.

The Court of Claims determined this case under a special jurisdictional act approved March 3, 1927 (c. 408, 44 Stat. Part 3, p. 1807), which reads as follows:

> *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-Fourth Congress, second session, be, and they are hereby referred back to the Court of Claims with jurisdiction to render such judgment as the findings of fact heretofore found and the law require: *Provided,* That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: *Provided further,* That the amount of any such judgment shall not exceed the sum of $50,000: *And provided further,* That such notice hereof shall be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States.

The petitioner herein filed an application for an appeal on April 23, 1929, which was allowed by the

Court of Claims on April 26, 1929. (R. 18.) The appeal, together with the petition for a writ of certiorari, is docketed in this Court as one cause. The petitioner herein has filed in this Court a statement in support of jurisdiction on appeal. The United States, within the time prescribed by the rules, has filed a jurisdictional statement contending that this Court is without jurisdiction to entertain the appeal.

STATEMENT

This case was heard by the Court of Claims as Congressional Case No. 6063, in which Findings of Fact were made by such Court on December 4, 1916. (R. 4.) By the Act of March 3, 1927, it was provided that the Findings of Fact made by the Court of Claims in said Congressional case "be, and they are hereby, referred back to the Court of Claims with jurisdiction to render judgment as the Findings of Fact heretofore found and the law require." The Court of Claims therefore sets forth the Findings of Fact made on December 4, 1916, as the Findings of Fact in the present case. (R. 4.)

These Findings show that one Simpson, on January 31, 1848, filed an application in the Patent Office for a patent for "conducting electricity through water." (R. 4.) No patent was ever issued upon this application. (R. 5.) On April 2, 1849, Simpson filed another application for patent, describing the process substantially as described in his application of 1848 (R. 5), which ap-

plication was rejected on the ground that the invention was not found new (R. 6).

On January 15, 1851, Simpson wrote the Commissioner of Patents relating to his application as follows (R. 6):

> I hereby withdraw my application for a patent for a mode of insulating telegraph wires, now in your office, and request that $20 may be refunded to me in gold, agreeable to an act of Congress in such case made and provided.

On December 24, 1858, Simpson filed another application for patent for a process of insulation of wires, which was also rejected upon the ground that the process was well known and also upon the ground that the invention was abandoned to the public. (R. 6.) Simpson appealed from this rejection to the Board of Committee of Appeals, where the rejection was affirmed. (R. 6.) On October 8, 1859, Simpson filed another application for patent for submarine telegraph cable, the same in subject matter as the preceding, which application was also rejected. Simpson appealed to the Board, who again reached their former conclusion. In May, 1860, the Commissioner of Patents confirmed the Board's decision. Simpson then appealed to the United States Circuit Court for the District of Columbia, where the action of the Commissioner of Patents was confirmed. (R. 7.)

On May 4, 1886, Simpson filed another application for patent similar to his previous applications,

and upon this patent No. 65019 was issued on May 21, 1867. (R. 7.) Simpson assigned his patent to one Eastman in 1871 and, on September 3, 1877, the patent passed, under Eastman's will to his wife, who, on November 15, 1877, individually and as executrix, transferred the patent to Clinton G. Colgate. (R. 8.) The transfer to Colgate was a voluntary assignment and not by operation of law. (R. 9.) The validity of this patent was sustained in the following cases: *Colgate* v. *Western Union Telegraph Co.,* 15 Blatch. 365; and *Colgate* v. *Gold and Stock Telegraph Co.,* 16 Blatch 503. (R. 7.)

The opinion in the *Western Union Telegraph case* gives what was then considered by the Court a complete history of the invention in question, and "is referred to for further information upon that subject." (R. 7.) After that decision the Telegraph Company paid Colgate $100,000 for past infringements and agreed upon license fees for future use. Some agreements were made with other parties. (R. 9.)

The United States Government, by its Signal Service and Weather Bureau, used submarine cables consisting of metallic wires employed as conductors of electricity encased in gutta-percha as an insulation between 1873 and 1883, and, at the rates fixed in other agreements, the claimant would be entitled to the sum of $50,000 for such use. (R. 9.)

The Court of Claims held that upon the facts found the petitioner could not recover, and therefore dismissed the petition. (R. 10–17.) The

Court held that under the jurisdictional act it was required to render judgment as the facts theretofore found and the law required, which meant that the validity of such patent should be determined, according to the facts as found in 1916, and an application thereto of the law as it existed at the time of the issue of the patent.

The patent statute of 1836 provided in part as follows:

> In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid.

The Court of Claims points out (R. 14) that the United States Circuit Court for the Southern District of New York in the case of *Colgate* v. *Western Union Telegraph Co.*, 15 Blatch. 365, did not have before it the above-quoted letter of January 15, 1851, from Simpson, which specifically withdrew the application for a patent, but only his letter dated January 13, 1851, as follows:

> Please pay to the order of George B. Simpson, claimant for insulation of telegraph wire, Twenty Dollars balance of patent fee to be refunded on rejection of claim. (R. 13.)

which that court concluded did not constitute withdrawal or abandonment of the application. The Court of Claims held that Simpson's letter of January 15, 1851, was an abandonment of the application and that, in view of such abandonment, petitioner could not recover. It therefore dismissed his claim.

ARGUMENT

The following are the Patent Statutes in force at the time of the applications by Simpson and the issue of the patent:

The Patent Act of 1836 (c. 357, 5 Stat. 117, 119), the pertinent portion of Sec. 7 of which provides:

> That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the

applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. * * * In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars.

The pertinent portion of Sec. 6 of the Patent Act of 1839 (c. 88, 5 Stat. 353, 354), provides:

> That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided,* That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent * * *.

Sec. 7 of the Patent Act of 1839 (c. 88, 5 Stat. 353, 354) provides:

> That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or

> composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

In the suit of *Colgate* v. *Western Union Telegraph Co.*, 15 Blatch. 365, in which Simpson's patent was sustained, the Circuit Court for the Southern District of New York made an examination of what was claimed and covered by the Simpson patent and held that the matters interposed by the defendant as tending to show that Simpson was not the first inventor thereof did not establish an earlier date than that of his first application in the Patent Office. The court also held that there had been no abandonment by Simpson of the invention or application for patent. The court, not having before it the letter of January 15, 1851, from Simpson to the Patent Office, in which he stated that "I hereby withdraw my application for a patent" and requested the return of his money in accordance with the statute applicable to such situations, held

that the letter from Simpson dated January 13, 1851 (R. 13), above quoted, did not amount to a withdrawal of his application. The court therefore determined that the several applications filed by Simpson should be considered as one continuing application, and the various steps taken therein as efforts to procure the allowance of the one continuing application. It therefore held that the date of the application was the date of the first application by Simpson, namely, January 31, 1848; and that the requirements of the Patent Acts of 1836 and 1839 had been fulfilled.

Upon the express evidence which is in this record of the withdrawal of the application, thus interrupting the alleged continuity thereof, the court's theory in sustaining the patent would necessarily have failed. It was not until December 24, 1858, almost eight years after the withdrawal, that another application for patent was made.

Simpson's letter of January 15, 1851, upon which the Court of Claims based the instant decision, was not brought to the attention of the Circuit Court, which decided the *Western Union Telegraph Company case,* until about six years after the original decision by Judge Blatchford, upon an application then made for a rehearing, in order that said letter might be considered. (*Colgate* v. *Western Union Telegraph Co.,* 19 Fed. 828.) The court denied such motion for rehearing, not because of any question as to the materiality or importance of such

letter, but because the letter had been available at the time of the original trial and should then have been produced and considered, and the defendant was accordingly barred by laches.

The holding by the Court of Claims is, therefore, not in conflict with the holding by Judge Blatchford in the Southern District of New York, and, even if it were, the decision by Judge Blatchford would not be controlling, but only persuasive, upon the Court of Claims. Finding VI (R. 7) of the Court of Claims shows that, unless the filing date of the original application by Simpson controls in this case, the invention had been described in printed publications in this and foreign countries, and had also been in public and common use prior to the application, and that articles covered by the invention had been the subject of purchase, sale, and prior use more than two years prior to the application.

Moreover, the withdrawal of the application in 1851 and failure to renew the application for a period of almost eight years constituted an abandonment, and when an application for a patent is abandoned no patent can thereafter be granted thereon. (*Consolidated Fruit-Jar Co.* v. *Wright*, 94 U. S. 92.)

The petitioner in its brief urges the doctrines of *stare decisis* and *res adjudicata*. It is true that there has been considerable litigation of this patent,

all in the United States Circuit Court for the Southern District of New York. The following is a list of the cases:

1. *Colgate* v. *Western Union Telegraph Co.*, 15 Blatch. 365, Fed. Case No. 2995, decided in 1878, was the judgment on a final hearing which has been heretofore discussed.

2. *Colgate* v. *Western Union Telegraph Co.*, Fed. Case No. 2494, was an order on a motion for violating the injunction granted in the case just referred to.

3. *Colgate* v. *Gold and Stock Co.*, Fed. Case No. 2991, 16 Blatch. 503, was a hearing on a motion for a preliminary injunction. An examination of this case shows that the court considered certain additional publications going to the question whether the patent was properly granted, and adhered to the theory which the court followed in the *Western Union case*, that the application was a continuing one, and determined that the publications introduced in that case which had not been presented in the *Western Union case* would not avoid the patent. The court did not discuss the question of the letter of January 15, 1851, or the abandonment.

4. *Colgate* v. *Gold and Stock Co.*, Fed. Case No. 2992, was an order on a motion for violation of the injunction granted in the preceding case.

5. *Colgate* v. *International Ocean Telegraph Co.*, Fed. Case No. 2993, was a hearing on a motion for an injunction.

6. *Colgate* v. *Compagnie Francaise, etc.,* 23 Fed. 82, was a demurrer to a bill of discovery.

7. *Colgate* v. *Western Union Telegraph Co.,* 19 Fed. 828, was the motion for rehearing to introduce the letter of January 15, 1851, which has been heretofore discussed.

8. *United States* v. *Colgate,* 21 Fed. 318, was a hearing on a motion by the Government for an injunction to restrain the commencement or prosecution of suits against private parties, made in a suit by the Government to repeal the Letters Patent. The court held that the Government has no such interest in the controversy as to entitle it to injunction. The decision does not pass upon the validity of the patent.

9. *United States* v. *Colgate,* 32 Fed. 624, was a hearing on a demurrer to the petition in the above suit filed by the Government to repeal the patent. The Court in the Southern District of New York sustained the demurrer. The Government took an appeal to the Supreme Court of the United States, which appeal was dismissed by the Solicitor General. (*United States* v. *Colgate,* 127 U. S. 792.) An examination of the record of the case (Supreme Court No. 198, October Term, 1887) shows that the petition alleged, among other things, that Simpson was not the first inventor, and that he knew that he was not, citing various alleged prior disclosures; that the action of the Circuit Court of the District

of Columbia deprived the Commissioner of Patents of jurisdiction to issue a patent, and that Simpson withdrew his application by a letter dated January 18, 1851 (which is the same letter as found by the Court of Claims to be dated January 15, 1851), and that Simpson abandoned the invention. The bill prayed for the cancellation of the patent and an injunction against Colgate prosecuting infringement suits.

The plaintiff demurred, assigning eight grounds therefor, including the grounds that the Government did not have sufficient interest to maintain the suit; that the petition showed Simpson was the first inventor and was guilty of no fraud and had not abandoned the patent, and that the petition failed to show wherein the Commissioner of Patents had no authority to issue the patent. The ruling by the Circuit Court, 32 Fed. 624, was to the effect that there was no allegation in the bill charging fraud or false suggestion upon the part of applicant, and that, at most, the allegations, if true, showed that there was no novelty in the invention and inferentially that he must have known there was no novelty. The court then said that, since the facts concerning novelty had been passed upon in the case of *Colgate* v. *Western Union Telegraph Co.*, that branch of the case did not require much consideration. The court held that the other aspect of the case, which charged that the Commissioner of Patents had no

jurisdiction to issue the patent after the decision by the Court of the District of Columbia, required more consideration. It determined, however, that such decision did not preclude a new application or the presentation of new facts to the Commissioner.

Upon the above review, it is submitted that the doctrine of *res adjudicata* has no application. The only case to which the United States was a party was the suit brought by it to cancel or repeal the patent. Such a suit is brought by the United States in a representative capacity on behalf of the public, and the grounds upon which it may be sustained are fraud, mistake, or lack of power. *United States* v. *American Bell Telephone Co.*, 128 U. S. 315; *United States* v. *American Bell Telephone Co.*, 159 U. S. 548, 555. Such grounds do not include lack of novelty in the invention, or abandonment of the application, or other grounds of invalidity ordinarily in issue in infringement suits. In the instant case the position of the United States is alleged to be that of an infringer, and the lack of identity between the issues here involved and those which were involved in the suit brought by the United States to repeal the patent is therefore manifest.

With respect to the contention of *stare decisis*, it may be pointed out that all of the decisions relied upon were in the Circuit Court for the Southern District of New York, which are not binding upon

the Court of Claims. Moreover, Simpson's letter of January 15, 1851, does not appear to have been considered except on the motion for rehearing in the *Western Union case,* which the court denied not because of lack of materiality of the letter but because the motion was made too late. The letter does appear in the record of the suit by the United States to repeal the patent, but, as above pointed out, could not properly have affected the decision of that case.

It is further submitted that, whether or not in an ordinary litigation the petitioner's contentions of *stare decisis* and *res adjudicata* would be entitled to any weight, they were properly denied by the Court of Claims in this case, brought under a special jurisdictional Act. The direction of Congress was that the findings of fact should be "referred back to the Court of Claims with jurisdiction to render judgment as the findings of fact heretofore found and the law require." The findings do not contain any mention of the suit by the United States to repeal the patent. They do contain a finding (R. 7) that the validity of the patent was sustained in the cases of *Colgate* v. *Western Union Telegraph Co.,* 15 Blatch. 365, and *Colgate* v. *Gold & Stock Telegraph Co.,* 16 Blatch. 503. We submit that it is not to be supposed that Congress intended the United States to be bound by these decisions. The "findings of fact heretofore found" showed the

use by the Government of the alleged invention and the extent thereof. (R. 9.) If the Government was to be precluded by reason of former decisions in another jurisdiction from raising any question as to the validity of the patent, there would have been nothing to refer back to the Court of Claims for determination. Adjudication of liability would have been unnecessary.

CONCLUSION

For the above reasons it is respectfully submitted that the decision of the Court of Claims is correct. It is further submitted that the case is of no public importance. It is scarcely conceivable that another like it will ever again arise. It is, therefore, not one which this Court should be called upon to review, and the petition for writ of certiorari should be denied.

Respectfully submitted.

CHARLES E. HUGHES, Jr.,
Solicitor General.

HERMAN J. GALLOWAY,
Assistant Attorney General.

JULY, 1929.

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SUPREME COURT OF THE UNITED STATES.

No. 74.—October Term, 1929.

Arthur E. Colgate, Administrator of the Estate of Clinton G. Colgate, Deceased, Petitioner, *vs.* The United States. } On Statements as to Jurisdiction on Appeal.

[November 4, 1929.]

Mr. Chief Justice Taft delivered the opinion of the Court.

The judgment of the Court of Claims, now under consideration, was given on a claim against the United States for alleged patent infringement, and was entered on February 4, 1929. A petition for certiorari seeking review in this Court was filed May 1, 1929, and was denied on October 14, 1929. The Government contends that both methods of review, either by appeal or certiorari, in this Court are now without avail.

The claim was referred by the Senate to the Court of Claims for an advisory finding and report of the material facts. A hearing was had in the Court of Claims and it reported its findings on the questions of fact. Thereafter the Court of Claims re-heard the case under a Special Jurisdictional Act of Congress approved March 3, 1927 (44 Stat. c. 408, Part 3, p. 1807), which read as follows:

"That the findings of fact made by the Court of Claims in the case of Arthur E. Colgate, administrator of the estate of Clinton G. Colgate, deceased, against the United States, Congressional, Numbered 6063, Senate Document Numbered 703, Sixty-fourth Congress, second session, be, and they are hereby, referred back to the Court of Claims with jurisdiction to render such judgments as the findings of fact heretofore found and the law require: Provided, That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of the judgment: Provided further, That the amount of any such judgment shall not exceed the sum of $50,000: And provided further, That such notice hereof shall

be given to the Attorney General of the United States as may be provided by orders of said court, and it shall be the duty of the Attorney General to cause one of his assistants to appear and defend for the United States."

Judgment for the Government in the re-heard case was given by the Court of Claims on February 4, 1929, based on a letter to the Commissioner of Patents under date of January 15, 1851, from Simpson, the then owner, specifically abandoning the application for the patent.

On April 23, 1929, Arthur Colgate, as administrator of Clinton Colgate, in pursuance of the Special Act, filed an application in the Court of Claims for the allowance of an appeal to this Court from the adverse judgment, and appeal was allowed by the Court of Claims on April 26, 1929. The appeal was docketed in this Court May 1, 1929, and on the same day a petition for a writ of certiorari was filed on the record in the appeal case. The petition for certiorari, as already said, was denied by us October 14th last. The case is now before us for consideration of the question of our jurisdiction upon the appeal.

We think the proper construction to be put upon this Special Act is that the review provided for was a petition for certiorari. One of the chief purposes of the General Act of February 13, 1925, ch. 229, 43 Stat. 936, was to abolish appeals from the Court of Claims to this Court and substitute therefor applications for writs of certiorari. The language of the Special Act is that "either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment *from which appeals now lie in other cases.*" At the time of the passage of that Act, no appeals generally "lay in other cases" from the Court of Claims to this Court, and do not now. It was evidently intended by the Act of 1925 to make the method of review by this Court of judgments of the Court of Claims, uniform. It was intended by the Act of 1925 to give this Court an opportunity to determine in advance whether the case was one worthy of review here. To hold that the case may come here only by certiorari is to make it conform to the general purpose of the Act of February 13, 1925, in enlarging the use of certiorari as a method of review in this Court. To describe appeals as from judgments "from which appeals now lie in other cases" is a mistake, unless one gives to the meaning of the word "appeals" something more than a mere technical mean-

ing. If what was intended was an appeal in its technical significance as distinguished from a certiorari, different words should have been used to indicate it. Therefore the Special Act must be construed to require that the review intended was the usual method of review at the date of the Special Act, which is and was by application for a writ of certiorari.

The case of *Sisseton and Wahpeton Band of Sioux Indians* v. *United States,* 277 U. S. 424, does not control the present case. That case had reference to another special act, granting the appellants one year from the date of the Act within which to appeal, and it was held to confer the right of appeal as distinguished from the right to petition for certiorari. That special act was approved March 4, 1927 (c. 522, 44 Stat., Part 3, p. 1847) and its purpose was to revive a right to appeal to this Court given to the same appellants by the Act of April 11, 1916 (39 Stat. 47, c. 63), but of which appellants had failed to avail themselves within the time limited therefor. Since Congress, by the 1927 Act, was merely extending the period for the exercise of a right conferred in 1916, the term "appeal", contained in the statute, was naturally construed with reference to its meaning at the time the right to it was originally granted. That was granted nearly nine years before the Act of February 13, 1925 changed the mode of appellate review of judgments of the Court of Claims from a technical "appeal" to a petition for writ of certiorari.

These provisions with respect to special review of cases from the Court of Claims should be carefully construed. They are generally embodied in exceptional legislation considered by other committees than the judiciary committees not especially advised as to the importance of uniformity in respect to such exceptions. It should, therefore, be clear, if a departure from the ordinary methods of limitation of review is intended by Congress, that the language should leave no doubt about it.

The history of the legislation and the language used show that the reference to appeals in the Special Act now before us finds its counterpart in other Acts having the same purpose. The language is that "either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment from which appeals now lie in other cases." Acts of this kind, although speaking of "appeals", show what is intended by the

phrase, "as in other cases". The list of the later Acts in legislation of this kind, after the passage of the Act of February 13, 1925, is as follows:

Act of March 3, 1925 (c. 459, 43 Stat. 1133, 1134), Kansas or Kaw Indians:

From the decision of the Court of Claims . . . an appeal may be taken by either party *as in other cases* to the Supreme Court of the United States.

Act of May 14, 1926 (c. 300, 44 Stat. 555), Chippewas of Minnesota:

With right of appeal to the Supreme Court of the United States by either party *as in other cases.*

Act of July 2, 1926 (c. 724, 44 Stat. 801), Citizen Band of Pottawatomies:

With the right of appeal to the Supreme Court of the United States by either party *as in other cases.*

Act of December 17, 1928 (c. 36, 45 Stat. 1027), Winnebago tribe:

With the right of appeal to the Supreme Court of the United States by either party *as in other cases.*

Act of February 28, 1929 (c. 377, 45 Stat. 1407), Shoshone tribe:

That from the decision of the Court of Claims in any suit prosecuted under the authority of this Act an appeal may be taken by either party, *as in other cases,* to the Supreme Court of the United States.

Act of July 3, 1926 (c. 734, 44 Stat. 807), Crow Indians:

With right of appeal to the Supreme Court of the United States by either party.

Act of March 2, 1927 (c. 250, 44 Stat. 1263), Assiniboine Indians:

With right of appeal to the Supreme Court of the United States by either party.

Act of March 3, 1927 (c. 302, 44 Stat. 1349), Shoshone Indians:

With right of appeal to the Supreme Court of the United States by either party.

Act of May 18, 1928 (c. 624, 45 Stat. 602), Indians of California:

With the right of either party to appeal to the Supreme Court of the United States.

Act of February 20, 1929 (c. 275, 45 Stat. 1249), Nez Perce tribe:

With the right of appeal by either party to the Supreme Court of the United States.

Act of February 23, 1929 (c. 300, 45 Stat. 1256), Coos (Kowes) Bay, Lower Umpqua and Siuslaw tribes:

And the right of appeal to the Supreme Court of the United States is hereby granted to both parties.

Here are included five instances in which the expression used describing the appeal is as one which would "lie in other cases", and the whole course of the legislation indicates a desire that the same appellate review should be given as in other cases. We think that this customary language requires the uniform use of the writ of certiorari in order to secure that which a certiorari gives—a preliminary examination of proceedings by this Court before review. Unless a special reason in the Act providing for appellate review indicates that the review is to be by technical appeal rather than by the ordinary method of certiorari, the latter method is the right one. This must lead to the dismissal of the present appeal.

A true copy.

Test:

Clerk, Supreme Court, U. S.